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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/435,718 11/08/99 RASMUSSEN

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QM12/1220

EXAMINER

DEXTER, C

ART UNIT

PAPER NUMBER

3724

DATE MAILED:

12/20/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/435,718**

Applicant(s)  
**Rasmussen**

Examiner  
**Clark F. Dexter**

Group Art Unit  
**3724**



☒ Responsive to communication(s) filed on Oct 31, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-16 is/are pending in the application.

Of the above, claim(s) 2 and 9-16 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1 and 3-8 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of Group II (claims 1 and 3-8) in the response filed October 31, 2000 (paper no. 6) is acknowledged. The traversal is on the ground(s) that (a) search and examination of the entire application could be made without serious burden, (b) restriction between groups I-V is improper because the identified groups do not fall into one of the classes of claims eligible for restriction as set forth in MPEP 806.05-806.05(I), (c) applicant has concluded that the Examiner has presumed that claim 1 is not patentable which is contrary to MPEP 806.05 (a), and (d) two-way distinctness is necessary and has not been established. This is not found persuasive for the following reasons.

Regarding (a), the Examiner respectfully disagrees that examining all of the claims would not create an undue burden. Rather, the examination of multiple inventions (i.e., subcombinations) in the time allotted for a single invention creates an undue burden on the Examiner, particularly since examining multiple inventions results in multiple fields of search and multiple scopes of invention leading to multiple patentability considerations. However, to relieve Applicants' burden, Applicants may state that one or some of the groups are not patentably distinct and the claims directed to this group or these groups will also be examined. It is noted, however, that such a statement may be used as an admission of obviousness and may be used in a rejection under 35 U.S.C. 103(a) of the other invention. Further, Applicants are reminded that if

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claims 3 or 4 as originally filed are determined to be patentable, rejoinder of the claims depending therefrom will be favorably considered.

Regarding (b), the Examiner respectfully disagrees that the identified groups do not fall into one of the classes of claims eligible for restriction as set forth in MPEP 806.05-806.05(I). The inventions are considered to fall under the category "Subcombinations Useable Together" which is covered in MPEP 806.05(d).

Regarding (c), the Examiner respectfully disagrees with applicant's conclusion that the Examiner has presumed that claim 1 is not patentable. The Examiner's position is that all of the claims including claim 1 are assumed to be patentable. However, an examination of the claims is required to support the assumption of patentability and it is necessary that the Examiner know which invention/subcombination to examine, particularly in the event, for example, that prior art is discovered which renders claim 1 unpatentable.

Regarding (d), the Examiner respectfully disagrees that two-way distinctness is necessary and has not been established. First, as explained above, the inventions are considered to be subcombinations useable together which only requires a showing of one-way distinctness. Second, two-way distinctness has been established for each of the groups in the Restriction Requirement (paper #5).

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 2 and 9-16 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

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***Information Disclosure Statement***

3. The information disclosure statement filed January 27, 2000 (paper #4) has been received and the references listed thereon have been considered.

***Drawings***

4. The drawings are objected to because in Figure 2, it seems that numeral 39 should be added to indicate the reserve web extending between reserve roll (R) and idler roller (29) for clarity; in Figure 3, numeral 17 (see page 9, line 19) is not shown, and it seems that it should be added to indicate the working web (e.g., the dashed lines extending past feature 59) for clarity; further, numeral 123 (see page 18, line 10) does not appear to be shown. Appropriate correction is required.

***Specification***

5. The disclosure is objected to because of the following informalities:

On page 10, line 18, "counterclockwise" appears to be inaccurate.

On page 12, line 10, a numeral or --(not shown)-- should be inserted after "ribs" for clarity; in line 11, "33" appears to be inaccurate, and it seems that it should read --19--; in line 21, the second occurrence of "25" appears to be inaccurate, and it seems that it should read --7--.

On page 14, line 2, "33" appears to be inaccurate, and it seems that it should read --25--.

Appropriate correction is required.

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***Claim Rejections - 35 USC § 112***

7. Claims 1 and 3-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 6-7, the phrase “resting, in the web-present position, on a pre-feed portion of sheet material web extending between the working roll and the nip” renders the claim vague and indefinite since the invention is being positively defined in terms of the web which is not part of the claimed invention.

In claim 3, lines 2-3, the phrase “contacts said pre-feed portion of sheet material web” renders the claim vague and indefinite since the invention is being positively defined in terms of the web which is not part of the claimed invention.

In claim 5, line 2, “a stub roll” is vague and indefinite as to whether it refers to that set forth in claim 4 (from which claim 5 depends) or to another such stub roll.

In claim 7, line 3, the phrase “resting upon the pre-feed portion of sheet material web in the web-present position” renders the claim vague and indefinite since the invention is being positively defined in terms of the web which is not part of the claimed invention.

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***Prior Art***

6. Further consideration of the claimed invention with respect to the prior art will be given upon clarification of the claimed invention.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.



**Clark F. Dexter  
Primary Examiner  
Art Unit 3724**

cfd  
December 18, 2000